

REMARKS

Claims 1 and 25 have been amended to clarify the subject matter regarded as the invention. Claims 1-46 and 48 remain pending.

Claims 1 and 25 were amended to substantially reflect their status prior to the January 12, 2009, amendment. The claims were originally amended in an attempt to expedite prosecution. However, since the Examiner persists in rejecting the claims, the Applicant has presented the claims in a manner that are fully justified in light of the prior art so that the claims are in proper condition for appeal.

The Examiner has rejected claims 1-46 and 48 under 35 U.S.C. §103(a) as being unpatentable over U.S. patent number 6,002,867 to Jazdzewski (Jazdzewski) in view of the *Ner® Framework Essentials, June 2001, O'Reilly®* document by Lam et al. (Lam) and the *Migrating Borland® Delphi™ applications to the Microsoft® .NET Framework with Delphi 8, February 2004, Borland Software Corporation* by Bob Swart (Swart).

The January 12, 2009, amendment added the limitation “and configured to allow migration of one or more tools and one or more programs from another form-based development system to the development system.” It is now apparent that instead of acquiescing to an unnecessary and improper request, the Applicant should have identified the clearly erroneous reasoning of the Examiner.

In the September 9, 2008, office action the Examiner responded that “In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., efficiently migrating existing programs and tools to a new development framework) are not recited in the rejected claim(s).” (Page 23).

The fact that the purpose of the invention was migration is wholly unnecessary to the claims but absolutely critical to determining whether a rejection under 35 USC 103(a) is proper. By failing to appreciate the context of the invention, the Examiner might as well cite a dictionary as prior art and issue a rejection under 35 USC 103(a) since all the words of the claim appear in the dictionary. In fact, that is essentially what the Examiner did by using Lam, a comprehensive 300+ page reference guide that “touches all the bases—from the Common Language Run-Time (CLR) and key class libraries to the specialized packages for ASP.NET, Windows Forms, XML Web Services, and data access (ADO.NET).” (Cited from the Google Books “About this book” section for the 3rd edition).

As was stated by the Applicant in the January 10, 2008, amendment, “At the outset, Applicant does not claim to invented the notion of forms or of source code based construction of an application which includes graphical user interface (window) elements. Applicant acknowledges that it is well known that graphical user interface elements may be described in textual (e.g., source code form) in order to generate a visual representation when the application source code is compiled and placed into production (i.e., at runtime).”

Since the *raison d'être* of the invention replicating something that existed before in an environment that is completely inhospitable to that thing, it is the height of absurdity to make the assertion that the very thing being replicated provides even a hint of suggestion, motivation or teaching of how to accomplish a migration to a new environment. Of course visual design of forms is desirable. It was desirable in the old environment and it continues to be desirable in the .NET environment.

Similarly, it is completely unsurprising that the individual elements used to achieve the migration are found within the .NET environment. Once again, the whole point of the invention is to be able to use the .NET environment in order to replicate a desirable user experience.

The relevant question is not whether the result is desirable, or whether the tools exist, but whether the specific mechanism used to achieve the claimed invention is obvious. The U.S. Supreme Court has unambiguously said, “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). “Inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.*

The Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**,” and, the Examiner must make “explicit” this rationale of “the apparent reason to combine the known elements **in the fashion claimed**.” *Id.* (emphasis added). Furthermore, this explicit rationale must meet the substantial evidence standard that is required of all USPTO findings. *Dickenson v. Zurko*, 527 U.S. 150 (1999). The Examiner has only addressed why the goal would be desirable without making any attempt whatsoever to explain a teaching, suggestion or motivation to combine the elements in the fashion claimed or in the way the claimed new invention does. In direct contravention of the Supreme Court’s explicit instructions, the Examiner has attempted to show obviousness by merely demonstrating that each claim element was independently known in the prior art.

For at least the reasons described above, Jazdzewski in view of Lam and Swart does not render claims 1-46 and 48 obvious.

Reconsideration of the application and allowance of all claims are respectfully requested based on the preceding remarks. If at any time the Examiner believes that an interview would be helpful, please contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott S. Kokka', with a stylized flourish at the end.

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